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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,737	09/11/2000	Miroslav Blumenberg	71369.172 and PFI-024US	5697

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EXAMINER

MONSHIPOURI, MARYAM

ART UNIT

PAPER NUMBER

1652

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/659,737 Applicant(s) Blumenberg et al.

Examiner Maryam Monshipouri Art Unit 1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-47 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 1-47 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6)  Other: \_\_\_\_\_

Art Unit:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-5, 22-23 and 25, drawn to an isolated molecule comprising MLK4 gene, vectors and host cells comprising said molecule and methods of expressing said molecule, classified in class 435, subclass 194.
2. Claims 6-10, 22-23 and 25, drawn to isolated DNA molecule comprising PAK4 gene and a vector comprising said molecule, classified in class 435, subclass 194.
3. Claims 11-16, 22-23, and 25 drawn to isolated DNA molecules comprising PAK5 gene, vectors and host cells comprising said molecule, classified in class 435, subclass 194.
4. Claims 17-23, and 25 drawn to isolated DNA molecules comprising YSK2 gene, vectors and host cells comprising said molecules and methods of expressing said molecule, classified in class 435, subclass 194.
5. Claims 24, drawn to isolated polypeptides comprising SEQ ID NO:4 expressed by PAK4 gene, classified in class 435, subclass 194.
6. Claim 24, drawn to isolated polypeptides comprising SEQ ID NO:13, expressed by YSK2 gene, classified in class 435, subclass 194.
7. Claim 24, drawn to isolated polypeptides comprising SEQ ID NO:2 encoded by MLK4 gene, classified in class 435, subclass 194.
8. Claim 24, drawn to isolated polypeptides comprising SEQ ID NO: 6, 8 or 10 encoded by PAK5 gene, classified in class 435, subclass 194.

Art Unit:

9. Claim 26-27 and 43, drawn to an antibody which binds SEQ ID NO:4 and a method of use if said antibody, classified in class 435, subclass 7.1.
10. Claim 26-27 and 43, drawn to antibodies which bind SEQ ID NO: 13 and a method of use of said antibody, classified in class 435, subclass 7.1.
11. Claim 26-27 and 43 , drawn to antibodies which bind SEQ ID NO: 2 and a method of use of said antibody and a method of use of said antibody, classified in class 435, subclass 7.1.
12. Claim 26-27 and 43, drawn to antibodies which bind SEQ ID NO: 6, 8, 10, and a method of use of said antibody, classified in class 435, subclass 7.1.
13. Claims 28-42 and 44-45, drawn to methods of screening for compounds that modulate cellula levels of JNKKK gene product using SEQ ID NO:4, classified in class 435, subclass 15.
14. Claims 28-42 and 44-45 drawn to methods of screening for compounds that modulate cellular levels of JNKKK gene product using SEQ ID NO:13, classified in class 435, subclass 15.
15. Claims 28-42 and 44-45 drawn to methods of screening for compounds that modulate cellular levels of JNKKK gene product using SEQ ID NO:2, classified in class 435, subclass 15.

Art Unit:

16. Claims 28-42 and 44-45 drawn to methods of screening for compounds that modulate cellula levels of JNKKK gene product using SEQ ID NO:6, 8, 10, classified in class 435, subclass 15.
17. Claim 46-47, drawn to a method of use MKL4 gene in a hybridization assay, classified in class 435, subclass 6.
18. Claim 46-47, drawn to a method of use PAK4 gene in a hybridization assay, classified in class 435, subclass 6.
19. Claim 46-47, drawn to a method of use PAK5 gene in a hybridization assay, classified in class 435, subclass 6.
20. Claim 46-47, drawn to a method of use YSK2 gene in a hybridization assay, classified in class 435, subclass 6.

The inventions are distinct each from the other for the following reasons:

The DNA of Group 1, The DNA of Group 2, the DNA of Group 3, the DNA of Group 4, the polypeptide of Group 5, the polypeptide of Group 6, the polypeptide of Group 7, the polypeptide of Group 8, the antibody of Group 9, the antibody of Group 10, the antibody of Group 11 and the antibody of Group 12 are patentably distinct each from the other because each product is directed to an unrelated chemical structure and function.

The invention of Groups 1-4 are each unrelated to the inventions of Group 13-16 because said products are neither made nor used by said products.

Art Unit:

Inventions 1-4 and 17-20 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the inventions of Group 1-4 can be used for recombinant preparation of MLK4, PAK4, PAK5 and YSK2, respectively, which are methods entirely different than any of those of Groups 17-20.

Inventions 5-8 and 13-16 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case each of the polypeptides of Groups 5-8 can be used for antibody preparation which are entirely different methods than each of those of Group 13-16.

The polypeptides of Groups 5-8 are each unrelated to each of the methods of Group 17-20 because said products are neither made nor used in said methods.

The antibodies of Group 9-12 are unrelated to any of the methods of Group 13-20 because said products are neither made nor used by any of said methods.

The methods of Groups 13-20 are patentably distinct each from the because each method has different steps and different end-points.

Art Unit:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their separate classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maryam Monshipouri, Ph.D. whose telephone number is (703) 308-1083.

The Examiner can normally be reached daily from 8:30 A.M. to 5:00 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. P. Achutamurthy, can be reached at (703) 308-3804. The OFFICIAL fax number for Technology Center 1600 is (703) 308-4242.

Art Unit:

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

  
Maryam Monshipouri, Ph.D.

Patent Examiner